

REMARKS

Claims 28 and 29 are objected to as both depending from claim 1. This was a typographical error. Claim 29 is made dependent from claim 10.

Claims 1, 3-4, 6-8 and 10-29 are rejected as being incomplete. Applicant traverses this rejection and submits that the claims are complete. Further, there is no requirement that an applicant must recite every step of a disclosed method in a claim.

Claims 1, 3-4 and 10-24 are rejected as being unpatentable over the newly issued (January 31, 2006, filed June 13, 2000) and newly cited patent to Labedz, et al., U.S. 6,993,576.

The Examiner has not indicated if the grounds of the rejection in the Final Rejection of April 6, 2005, to which applicant went to great trouble and expense in responding by way of filing a Brief on Appeal, are still active or have been withdrawn.

Applicant submits that Labedz is not a valid reference and is "sworn behind" under 37 CFR §1.131 based on the Declaration of the undersigned submitted with this amendment.

Background

The subject application was originally filed on November 2, 2000. An RCE was filed on March 15, 2004.

In the RCE a first Action (Final Rejection) was issued on April 6, 2005. The principal ground of rejection was based on the BuildingLink.com publication in view of the BJM publication and further in view of a then newly cited patent to Shavit, U.S. 4,799,156.

Instead of filing an amendment to the Final Rejection, applicant filed a Notice of Appeal and on November 3, 2005 filed a Brief on Appeal.

After the Appeal Brief was filed the Examiner called the undersigned and suggested amendments to the claims that would distinguish over the references applied in the April 6, 2005 Final Rejection. On January 19, 2006 a proposed amendment to the claims was informally submitted. The Examiner indicated informally to the undersigned that the proposed amendment of January 19, 2006 was acceptable to him and that, subject

to approval by a reviewing committee, the proposed claim amendment of January 19, 2006 would be entered as an Examiner's Amendment and the application would be allowed.

Instead of receiving the expected and hoped for Notice of Allowance, on March 13, 2006 an Office Action, which was a Final Rejection, was issued rejecting the claims presented in the Appeal Brief of November 3, 2005, i.e., the claims present in this application at the time of filing the RCE on March 14, 2004 and the Final Rejection of April 6, 2005. Many of the same formal rejections are those set forth in the April 6, 2005 Final Rejection. The new reference to Labeledz, which was granted on January 31, 2006, was cited and applied in rejecting all of the claims in the application. This reference has a U.S. filing date of June 13, 2000, less than five months prior to the filing of this application.

Rule 131 Declaration

A. Facts

A Declaration of the undersigned (hereinafter "Coplein Declaration") is submitted with Exhibits. It is respectfully submitted that this Declaration shows an earlier date of invention than the June 13, 2000 filing date of the application on which the Labeledz patent is based. The facts pertinent here are (all references to Exhibits are those attached to the Coplein Declaration):

1. The U.S. filing date of the Labeledz reference to which prior invention is to be shown is June 13, 2000 (Exhibit B).
2. The subject application was filed on November 2, 2000 and claims the benefit of priority of a Provisional Application Serial No. 60/221,652, filed on July 28, 2000 (Exhibits A and C).
3. The Coplein Declaration Exhibit D is the disclosure document on which the Provisional Application and the subject application were based. This disclosure was received by the undersigned no later than June 7, 2000 as shown by the e-mail of June 7, 2000 (Exhibit E). The disclosure (Exhibit D) is evidence of conception.

4. Exhibit F is a memo containing a drawing corresponding to the disclosure (Exhibit D) that was sent on September 28, 2000 to my secretary to be forwarded to a draftsman to have a formal drawing for this application made. This shows that the materials of the disclosure (Exhibit D), which are carried over to the Provisional application (Exhibit A) also appear in this application as Figs. 1 and 2.

B. Argument

The first part of 37 CFR §1.131 provides that

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

The Declaration of the attorney of record should be acceptable as acting in a representative capacity, 37 CFR §1.34.

37 CFR §1.131 continues:

b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

As noted above, the subject application claims priority of the Provisional Application Ser. No. 60/221,652. 35 U.S.C §119 (e) states:

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or

section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. [emphasis added]

The subject application was filed meeting all of the requirements of 35 U.S.C. §119(e)(i), i.e., filed within twelve months of the Provisional Application, claiming priority, and having the same inventors.

Reading 37 CFR §131 and 35 U.S.C. 119(e)(1) together and applying them to the instant situation, due diligence has to be shown only for the period when the disclosure dated 06/07/2000 (Exhibit D) was received and the filing of the Provisional application (Exhibit A) on July 28, 2000. The disclosure (Exhibit D) is evidence of conception and the Provisional Application (Exhibit A) is constructive reduction to practice. As stated in the Coplein Declaration, preparation of the subject application began at the time of receiving the disclosure (Exhibit B) and a decision was made in July 2000 to file the Provisional application during the time of preparation of the subject application. This shows due diligence.

The 06/07/2000 disclosure (Exhibit D) was used as the Provisional application (Exhibit A). Both the disclosure and the provisional application, in essence, comprise the subject application revised to a form more common to U.S. patent applications. Reference is made to the subject matter, such as on pages 3-7 and 9-13 of Exhibits A and D. Also compare the drawings of the subject application which are basically formalized versions of the figures on pages 14-19 of the Disclosure.

Accordingly, due diligence has been shown for the period from June 7, 2000, the date of the disclosure (Exhibit D) which is evidence of even more than mere conception of the invention, to the date of constructive reduction to practice by the filing of the Provisional application on July 28, 2000. If necessary, there was a further constructive reduction to practice as evidenced by the filing of the subject application on November 2, 2000. Due diligence for the latter is illustrated by Exhibit F of September 28, 2000.

For the reasons given above the Labeledz patent, having a filing date of June 13, 2000, should be withdrawn as a reference.

Request of Withdrawal of Final Rejection

The March 12, 2006 Office Action was a first Action Final Rejection.

Several attempts were made by the undersigned to reach the Examiner during the month of April 2006, but the Examiner was not available. On May 5, 2006 the undersigned spoke with the Examiner. Much of the above history set forth in the Background section above was recounted. The undersigned explained to the Examiner that he believed the newly issued Labeledz patent cited in the March 13, 2006 Final Rejection would be overcome by a Rule 131 Declaration.

The undersigned also requested that the Final Rejection be withdrawn. It was explained that:

1. Applicant had no chance to properly respond to a newly cited reference that was cited not because of any amendment to the claims, but because of its new issuance. There would be no opportunity to amend the claims because any amendment of substance would undoubtedly be considered to raise a new issue and would not be entered.
2. Assuming that the Rule 131 Declaration was successful in overcoming the newly cited reference, then would applicant be again placed back in the appeal stage?
3. If the proposed informal amendment of January 19, 2006, which was supposed to be acceptable as placing the application in condition for allowance, was submitted with this amendment, it also would undoubtedly be considered as raising a new issue.

The Examiner indicated that he would check the request to withdraw the Final Rejection with his supervisor. The Examiner did this, called back and indicated that his supervisor would not withdraw the Final Rejection.

As seen from the above, applicant has been placed in a "Catch 22" situation.

The request to withdraw the Final Rejection is repeated and should be granted.

Application No. 09/704,322
Amendment dated May 12, 2006
After Final Office Action of March 13, 2006

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Docket No.: 03188/100H005-US1

Conclusion

Withdrawal of the Labedz patent as a reference is proper based upon the Rule 131 Declaration. The amendment should be entered for this purpose.

Upon entry of the amendment, if the appeal stage is resumed, then the undersigned would be willing to re-submit and agree to entry of the informally submitted amendment of January 19, 2006.

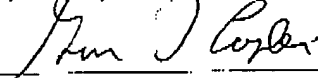
Two month Submission

This amendment is being submitted within two months of the March 13, 2006 date of the Final Rejection.

Prompt and favorable action is requested.

Dated: May 12, 2006

Respectfully submitted,

By 

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